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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/777,412
Filing Date: February 12, 2004
Appellant(s): NGUYEN ET AL.

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EXAMINER'S ANSWER

This is in response to the appeal brief filed 27 July 2010 appealing from the Office action mailed 15 June 2009.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application: 21, 29, 31 and 44-53 (all claims currently pending).

(4) Status of Amendments After Final

No Amendments to the claims were filed subsequent to the Final Office Action¹.

01 September 2009 - An After Final Response was filed on 01 September 2009 with a new claim list. No amendments were made to the claims in said list filed on 01 September 2009.

¹ **01 September 2009** - An After Final Response was filed with a new claim list.
16 September 2009 - Advisory Action mailed. Said Response was entered therein.
15 December 2009 - Notice of Appeal filed.
15 December 2009 - A Pre-Brief Review Request was filed.
07 January 2010 - A Response thereto was mailed to Appellants.
27 July 2010 - Appeal Brief filed on 27 July 2010 with Petition to Revive Unintentional Abandoned Application under 37 C.F.R. 1.137(b).
31 August 2010 - Petition Granted.

16 September 2009 - Said Response was entered in the Advisory Action Mailed on 16 September 2009.

(5) Summary of Claimed Subject Matter

The following cross-reference of Brief citations to paragraph numbers employed in the specification as filed. This cross-reference is for the convenience of the Board of Appeals:

Brief (at pages 4 to 6)	Original Specification (paragraph no.)
p. 7, ll. 17- 21	[0019]
p. 4, ll. 7-9	[0010] (1 st 3 lines thereof)
p. 5, ll. 14-17	[0013] (1 st 4 lines thereof)
p. 1, ll. 17-20	[0002] (1 st 4 lines thereof)
p. 4, ll. 9-15	[0010] (1 st lines 3-11 thereof)
p. 3, ll. 7-19	[0007] (lines 6-18 thereof)
p. 5, l. 14 - p. 6, l. 3	[0013] to [0014]

The examiner has no further comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

5,582,250	Constien	12-1996
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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The quotation of 35 U.S.C. 102(b) and 35 U.S.C. 103(a) which forms the basis for all obviousness rejections is set forth in the previous Office Actions and is herein incorporated by reference.

Claims 21, 29, 31 and 44-53 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Constien, US 5,582,250.

See column 5, lines 40-65; and claims wherein the proppant (such as ceramic spheres, column 3, lines 61 et seq) is combined/added to brine (column 5, lines 43 et seq) after the other conventional additives for specific well conditions, wherein the ZnBr_2 brine may be employed. Constien (column 5, lines 8 et seq) discloses polymer resin viscosifying agents as interpolymers with sodium or potassium halides as electrolytes (column 5, line 39).

Said ZnBr_2 brine containing proppant reads on the coated particulate proppant since the proppant remains particulate when added and is coated with the polymer resin viscosified ZnBr_2 in the brine.

The instant claims read on the Constien reference, which clearly envisage fracturing compositions. The Constien reference explicitly discloses each of the claimed components, wherein the interpolymers read on the claimed resins, the ZnBr_2 reads on the tracer and the brine-containing fracturing fluid coats the proppant particulate material.

To the extent the Constien reference differs from the claims in the particulate material with sufficient specificity, Constien clearly contemplates compositions of proppant and ZnBr_2 brine and alkali metal halides reading on the tracking salts.

It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ the ZnBr_2 brine and alkali metal halides as brine constituents for their viscosifying, density and crystallization temperature properties recognized in the Constien reference.

To the extent Constien differs from the additives of the dependent claims. These are well known additives clearly contemplated in the Constien reference as special additives for specific well applications.

(10) Response to Argument

Findings of Fact

(1) Independent claims 21, 44, and 49 are directed particulate compositions characterized as a proppant composition as follows (in part):

Art Unit: 1762

21. A proppant composition comprising a particulate material that has been coated with a coating composition comprising a homogenous blend of a tracking composition and a resin composition, wherein the tracking composition comprises a substantially non-radioactive tracking material selected from the group consisting of:

a metal salt wherein a metal portion of the metal salt is selected from the group consisting of gold, silver, lithium, molybdenum, and vanadium; and

a metal salt selected from the group consisting of barium bromide, barium iodide, beryllium fluoride, beryllium bromide, beryllium chloride, cadmium bromide, cadmium iodide, chromium bromide, chromium chloride, chromium iodide, cesium bromide, cesium chloride, sodium bromide, sodium iodide, sodium nitrate, sodium nitrite, potassium iodide, potassium nitrate, manganese bromide, zinc bromide, zinc iodide, sodium monofluoroacetate, sodium trifluoroacetate, sodium 3-fluoropropionate, potassium monofluoroacetate, potassium trifluoroacetate, and potassium 3-fluoropropionate.

44. A proppant composition comprising particulate material that has been coated with a coating composition comprising a tracking composition and a resin composition, wherein the tracking composition comprises a substantially non-radioactive tracking material selected from the group consisting of: . . . zinc bromide, . . . 3-fluoropropionate.

49. A proppant composition comprising a particulate material that has been coated with a coating composition comprising a tracking composition, wherein the tracking composition comprises a substantially non-radioactive tracking material, wherein the substantially non-radioactive tracking material comprises at least one metal salt selected from the group consisting of: . . . zinc bromide, . . . 3-fluoropropionate.

The remaining species² to the “non-radioactive tracking material” in claims 44 and 49 have not been included here since these are not part of the present rejection.

(2) All the pending claims employ open transition language, *e.g.*, “comprising”.

(3) None of the pending claims limit the “resin”, *e.g.*, “hardened”, “layered”, “epoxy-resin”.

(4) None of the pending claims limit the “coating” beyond the “coating composition”, *i.e.*, “**comprising** a tracking composition” or “**comprising** a homogenous blend of a tracking composition and a resin composition”.

(5) None of the pending claims limit the method the particulate material is “coated”.

(6) All the pending claims read on and include “zinc bromide” as “a tracking material” species.

(7) All the pending claims lack any limitation of component concentration, relative or based on the total composition.

(8) Claim 49 does not require a resin but is directed to particulate material containing compositions. This is provided for in dependent claim 52, which is dependent thereon. Claim 49, by definition encompasses non-resin containing coatings. See 37 CFR 1.75(c). Appellants argue claims 49-51 separately.

(9) The claims employ the limitation to a “composition comprising a particulate material that has been coated with a coating composition comprising”. The specification

² The two groups of metal salts claimed (see claim 21) have been interpreted as alternative groups of tracking materials, which is consistent with the coated particulate material disclosed in the original specification. Appellants have not asserted two salts are coated.

Art Unit: 1762

does not specifically define the term “coated” or the method of coating the particulate material.

(10) Appellants further state ([0002], BACKGROUND):

The present embodiment relates generally to . . . non-radioactive compositions . . . for determining the source of treatment fluids being produced from a production formation having multiple zones. For example. . . well bore.

Appellants state ([0007], DETAILED DESCRIPTION):

According to one embodiment, to determine from which zone(s) a fluid is being produced, a water soluble inorganic or organic salt is dissolved in the base treatment fluid as the fluid is being pumped downhole during the treatment. Such. . . 3-fluoropropionate.

Appellants further state ([0010], DETAILED DESCRIPTION):

According . . . Mallinckrodt Baker, Inc. It is understood, however, that field grade materials may also be used as suitable tracer materials for tagging onto proppant material or materials to be blended with proppant material. . . . material.

Appellants further state ([0015], DETAILED DESCRIPTION):

For proppant to be **coated** with a curable resin, the tracer agent is blended homogeneously with the resin mixture and the resin is then coated onto the proppant. The . . . tracer agent.

Appellants further state ([0025], DETAILED DESCRIPTION):

Although only a few exemplary embodiments have been described in detail above, those skilled in the art will readily appreciate that many

other modifications are possible in the exemplary embodiments without materially departing from the novel teachings and advantages described herein. Accordingly, all such modifications are intended to be included within the scope of the following claims.

Lastly, Appellants disclose ([0015], instant specification) the proppant **can be coated on-the- fly during** the fracturing job **treatment**.

(11) Appellants do not provide any admitted evidence to rebut the anticipation or obviousness rejections.

Conclusions and Reasoning for Anticipation and Obviousness

(I)(i) Anticipation of claims 21, 29, 31, 44-48, 52, and 53 (i.e., resin containing)

The breadth of the instant claims encompass and read on the fracturing fluids disclosed and clearly envisaged in the Constien reference.

The Constien reference discloses fracturing fluids.

The Constien reference discloses ZnBr_2 brine-containing fracturing fluids.

The Constien reference discloses particulate material as proppants in said fracturing fluids.

The Constien reference discloses water-dispersible polymers having a number average molecular weight of one million or more in said fracturing fluids.

Appellants' invention ([0002] and [0003], BACKGROUND) clearly includes fracturing fluid compositions.

Appellants' use of open transitional language of the claims does not exclude further ingredients in the fracturing fluids (*Findings of Fact*, (2)).

Appellants' claims do not limit the "resin" (*Findings of Fact*, (3)).

Appellants' claims do not limit "coated", which is a simple ordinary English word having an accepted meaning (*Findings of Fact*, (5) and (9)).

Appellants' disclose ([0010], DETAILED DESCRIPTION) the use of field grade materials (e.g., conventional brine, conventional resin) as suitable tracer materials (*Findings of Fact*, (10)).

Appellants disclose ([0015], instant specification) the proppant **can be coated on-the- fly during the fracturing job treatment** (*Findings of Fact*, (10)).

The logical conclusion, factually and legally, is the breadth of the instant claims consistent with Appellants' disclosure read on and are anticipated by the Constien fracturing fluids.

(I)(ii) Obviousness of claims 21, 29, 31, 44-48, 52, and 53 (i.e., resin containing)

Constien clearly contemplates compositions of proppant, ZnBr_2 brine and alkali metal halides reading on the tracking salts. Constien (column 5, lines 8 et seq) discloses polymer resin viscosifying agents as interpolymers with sodium or potassium halides as electrolytes (column 5, line 39) and molecular weight of 1 million or more. Constien reference (column 5, lines 43 et seq) clearly contemplates well known additives for specific well applications.

It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ the ZnBr_2 brine and alkali metal halides as brine constituents for their advantageous viscosifying, density and crystallization temperature properties recognized in the Constien reference.

(II)(i) Anticipation of claims 49-51 (i.e., no resin)

Claims 49-51 do not require a "resin" but are directed to particulate material coated with a tracking composition comprising zinc bromide. (*Findings of Fact*, (2)-(5) and (8)).

Appellants' use of open transitional language of the claims does not exclude further ingredients in the fracturing fluids (*Findings of Fact*, (2)).

Appellants' claims do not limit "coated", which is a simple ordinary English word having an accepted meaning (*Findings of Fact*, (5) and (9)).

Appellants' disclose ([0010], DETAILED DESCRIPTION) the use of field grade materials (e.g., conventional brine, conventional resin) as suitable tracer materials (*Findings of Fact*, (10)).

Appellants disclose ([0015], instant specification) the proppant **can be coated on-the- fly during** the fracturing job **treatment** (*Findings of Fact*, (10)).

The logical conclusion, factually and legally, is the breadth of the instant claims consistent with Appellants' disclosure read on the Constien fracturing fluids.

(II)(i) Obviousness of claims 49-51 (i.e., no resin)

Constien clearly contemplates compositions of proppant and ZnBr_2 brine and alkali metal halides reading on the tracking salts. Constien reference (column 5, lines 43 et seq) clearly contemplates well known additives for specific well applications.

It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ the ZnBr_2 brine and alkali metal halides as brine constituents for their advantageous viscosifying, density and crystallization temperature properties recognized in the Constien reference.

Appellants' Arguments

(A) Appellants (page 6, section VII, A) assert the examiner has incorrectly applied the standard for interpreting the claims during prosecution. Appellants conclude

Art Unit: 1762

the examiner has misinterpreted the claims based on the applied standard. This has not been deemed persuasive for the following reasons.

Initially, Appellants' more narrow interpretation of the claims based on a preferred example (*i.e.*, Santrol resin, Acme Borden resin, or Dewprashad et al epoxy-resin) does not support their conclusion of improper interpretation of the claims by the examiner. The examiner's interpretation is consistent with the disclosure as it would have been interpreted by one having ordinary skill in the art at the time of the invention.

See also *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) (patentability may not be based on elements not present in the claims).

Furthermore, Appellants could have limited the "resin composition" but appear to have chosen not to limit said "resin composition". See Advisory Action mailed 16 September 2009 (Continuation of 11, 3rd full paragraph). See MPEP 2111:

"Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969)".

(B) Appellants (page 7 to 8, section VII, A, section i) state their interpretation of the standard for interpreting claims during prosecution. Appellants' remarks regarding claim interpretation during prosecution are noted with the following comments.

(a) Initially, evidence relied upon by appellants must be entered, admitted and/or cited during prosecution. Reference to the definition evidence at page 10 (Brief) and the footnote bridging pages 10 and 11 (Brief) including the Schlumberger website and

Art Unit: 1762

oilfield glossary definitions is an improper evidence citation and should be disregarded by the Board of Appeals as evidence that was not admitted into the record. See 37 CFR 41.33(c)(2). Also, Appellants' **Evidence Appendix** designation: **None**, is noted.

See also, MPEP 2111 regarding claim interpretation, particularly:

“... words of the claim must be given their plain meaning unless **>the plain meaning is inconsistent with< the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (discussed below); *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004) (Ordinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say.”

(C) Appellants' (pages 8 and 9, Brief) characterization of the word or term “coated” is noted. The examiner has given each limitation patentable weight consistent with the disclosure and the prior art as it would have been interpreted by one having ordinary skill in the art at the time of the invention.

(D) Appellants' (pages 9, 10 and 11, Brief) characterization of the words or terms “resin composition” and “coated” are misplaced as follows.

(a) Reliance on the Schlumberger website and oilfield glossary definition is misplaced and improper since it relies on evidence not admitted into the record, which Appellants raise for the first time in the Brief.

(b) Reference and quotation (page 10, Brief, referring to [0015], instant specification) is misplaced and amounts to an argument that disclosure in the specification of a preferred embodiment distinguishes claims to the genus. This clearly

Art Unit: 1762

fails since the breadth of the claims read in light of the disclosure are anticipated by or obvious over the prior art.

The full content, which Appellants cite a portion, in Appellants' specification paragraph [0015] reads:

For proppant to be **coated** with a curable resin, the tracer agent is blended homogeneously with the resin mixture and the resin is then coated onto the proppant. The proppant can be pre-coated as in the case of curable resin-coated proppants, **for example**, such as those commercially available from Santrol or Acme Borden, **or it can be coated on-the- fly during the fracturing job treatment**. The nature of the resin materials and the processes for performing the coating process is well known to those skilled in the art, as represented by U.S. Patent No. 5,609,207 to Dewprashad et al., the entire disclosure of which is hereby incorporated by reference. (Examiner's emphasis).

This is an **example** ([0015], instant specification) of a coated particulate material but does not specifically limit the claim. This amounts to reading preferred embodiments into the claim. See MPEP 2111.01(II), *E-Pass Technologies, Inc. v. 3Com Corporation*, 343 F.3d 1364, 1368, 67 USPQ2d 1947, 1949 (Fed. Cir. 2003), and *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983). When no explicit definition for a term is given, it should be given its ordinary meaning and broadest reasonable interpretation. It should not be limited to preferred embodiments in the specification. Limitations not in the claims should not be read into the claims.

(c) Reference and quotation (page 10, Brief) regarding Dewprashad et al '207 is an even further preferred resin. While the entire disclosure of Dewprashad et al '207 is

Art Unit: 1762

incorporated by reference, Appellants do not reference a specific portion of Dewprashad et al '207 in the instant specification and argue the instant claims are distinguished based on a preferred epoxy resin of Dewprashad et al '207. See MPEP 2111.01(II), *E-Pass Technologies, Inc. v. 3Com Corporation*, *supra*, and *In re Marosi*, *supra*.

(d) Appellants' (pages 10 and 11, Brief) conclusion that the claimed invention requires low solubility capable of coating the particulate material and would not include high soluble material is based on an incorrect premise. These features are not recited in the claims on appeal. Therefore, it is immaterial whether the feature is disclosed in prior art reference relied upon. See *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) (patentability may not be based on elements not present in the claims).

The Constien reference (column 4, lines 60-63; and column 5, lines 30-32) discloses water-dispersible interpolymers polymers having a number average molecular weight of about one million or more.

(E) The Constien reference

(I)(i) Anticipation of claims 21, 29, 31, 44-48, 52, and 53 (i.e., resin containing)

(a) Appellants (pages 11 and 12, particularly top of 12 et seq) assert that because the Constien polymers function to viscosify, they are aqueous phase-soluble and are allegedly distinct from a resin based on said solubility. Appellants conclude Constien does not anticipate the use of resin.

This has not been deemed persuasive since Constien, as recognized by Appellants, discloses water-dispersible interpolymers. Constien further disclose said polymers have a molecular weight of 1 million or more. The claims do not exclude

Art Unit: 1762

resins having a viscosifying function and breadth of the instant claims consistent with their disclosure. See above (*Findings of Fact*, (10)).

(b) Appellants (pages 12 and 13) assert the Constien polymers are not curable. Initially, the claims require resins. They do not require “curable resins”. The “patentability may not be based on elements not present in the claims”, *In re Self, supra*.

Furthermore, even curable polymers would not distinguish the claims over Constien. A “curable polymer” is merely capable of being cured. Curing is open to addition reactions, free radical reactions, condensation reactions, *etc.* Constien at least discloses (column 5, line 26) polymers having “alkenyl” substituents, which are capable of addition or free radical reactions and/or curing. Constien at least discloses (column 5, line lines 5-26) polymers having condensable groups (*e.g.*, acids), which are capable of curing by condensation reactions.

Appellants (page 13) argument regarding the implicitly or inherency of “curable groups” within the Constien polymers is misplaced for the reasons above. Furthermore, the claims fail to limit the resins to “curable resins”, the specification fails to specifically define the term “curable”, the specification fails to limit any particular method of curing or the degree of cure. Appellants have proffered no scientific reasoning or evidence that the Constien polymers, which are disclosed as having conventional polymer functional groups of known reactivity, could not be cured. Constien discloses polymers reading on the claims resin.

(c) Appellants (page 14) assert the claimed “coated” limitation distinguishes the claims over Constien based on the order of addition of the coating composition to the

Art Unit: 1762

particulate material. Initially, “patentability may not be based on elements not present in the claims”, *In re Self, supra*. Appellants’ argument appears inconsistent with the disclosure at [0015] that the particulate material **can be coated on-the- fly during** the fracturing job **treatment**.

The instant claims are directed to compositions rather than methods. Patentability is based on the product itself rather than its method of production. While the structure implied by the process steps should be considered when assessing patentability of product-by-process limitations, the method of coating has not been specifically defined by Appellants. The claims do not exclude immersion and/or dispersion coating.

(II)(i) Anticipation of claims 49-51 (i.e., no resin)

(a) Appellants (pages 14 and 15) assert the claimed “coated” limitation distinguishes the claims over Constien based on the order of addition of the coating composition to the particulate material. Initially, “patentability may not be based on elements not present in the claims”, *In re Self, supra*. Attention is directed to the preceding two paragraphs regarding claims having a resin component in the coating composition.

(I)(ii) Obviousness of claims 21, 29, 31, 44-48, 52, and 53 (i.e., resin containing)

(a) Appellants (pages 16 to 20) assert the examiner has not established a *prima facie* case of obviousness. This is not deemed persuasive for the reasons to follow.

(b) Appellants (pages 16 and 17, particularly top of 17 et seq) assert the same argument based on the resin as presented at pages 11 and 12, particularly top of 12 et

seq, for anticipation. This has been addressed above. Said claims are at least obvious over Constien for the reasons herein above.

(c) Appellants (pages 18 and 19) assert the same argument based on the resin as presented bridging pages 12 and 13 for anticipation. This has been addressed above. Said claims are at least obvious over Constien for the reasons herein above.

(d) Appellants (page 19) assert the same argument based on the resin as presented at page 14 for anticipation. This has been addressed above. Said claims are at least obvious over Constien for the reasons herein above.

(e) Appellants (page 20) argue that changing the process order as in Constien would change the principal operation of the claimed invention and is a teaching away from their claimed invention. This has not been deemed persuasive since Appellants' conclusion is based on a narrow claim interpretation to preferred embodiments that have not been claimed.

Furthermore, Appellants disclosure clearly includes multiple embodiments [0010] of tracking tracers with proppants and the specification makes no distinction between their modes of operation. Differences between Appellants' preferred embodiments and the claims does not distinguish, teach away, or render unobvious the broader scope of the claims taught in the prior art.

Appellants appear to be arguing the separate embodiment ([0016]) of proppants tagged with a permanent tracer, which the claims are not limited. See *In re Self, supra*.

(II)(i) Obviousness of claims 49-51 (i.e., no resin)

(a) Appellants (page 21) assert the same argument based on the resin as presented at pages 14 and 15 for anticipation. This has been addressed above. Said claims are at least obvious over Constien for the reasons herein above.

(b) Appellants (pages 21 to 22) argue that changing the process order as in Constien would change the principal operation of the claimed invention and is a teaching away from their claimed invention. This has not been deemed persuasive since Appellants' conclusion is based on a narrow claim interpretation to preferred embodiments that have not been claimed. This has been addressed above. Said claims are at least obvious over Constien for the reasons herein above.

Furthermore, the contrast between claim 49 and claims 21 and 44 make it evident that the original disclosure clearly contemplates coating compositions broader than the preferred resin compositions characterized in Appellants arguments (pages 8 to 10, and pages 20 to 22, Brief).

For the reasons herein above claims 21, 29, 31 and 44-53 are deemed to be Anticipated by or at least Obvious over the Constien reference and said rejections should be affirmed.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Conclusion

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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